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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LCB398

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on December 15, 2005

Signature

Typed or printed
name

Tina Langdon

Application Number

10/613,062

Filed

07/03/2003

First Named Inventor

Jack E. Caveney

Art Unit

3677

Examiner

Jack W. Lavinder

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 44,618☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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12/15/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

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Attorney Docket No. LCB398

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jack E. Caveney)	
)	Art Unit: 3677
Serial No.:	10/613,062)	
)	Examiner: Jack W. Lavinder
Filed:	July 3, 2003)	
)	
For:	Ball Lock Cable Tie)	
	Having Stiffening Ribs)	

Remarks in Support of Pre-Appeal Brief Request for Review

Claims 7-12 and 20-24 are pending in the present Application. The Examiner rejected claims 7-9, 11-12, and 20-24 under § 103(a) as being unpatentable over *Blanks* (U.S. 5,732,446) in view of *Andersen* (U.S. 6,035,495) and *Sauer* (U.S. 4,300,270). The Examiner also rejected claim 10 under § 103(a) as being unpatentable over *Blanks* in view of *Andersen* and *Sauer*, and further in view of *Thurston* (U.S. Re 25,769). However, Applicant submits that claims 7-12 and 20-24 are patentable over *Blanks*, *Andersen*, *Sauer* and *Thurston*, taken alone or in combination.

Independent claim 7 recites ". . . an elongate metallic strap having a first end and a second end opposite the first end, a hooked portion formed integral with the first end and a return loop connecting the first end to the hooked portion, wherein the return loop includes at least one rib disposed thereon." As best seen in FIGS. 1 and 6, the return loop connects the first end 26 of the strap 28 to the hooked portion 34, and the return loop includes at least one rib 38 disposed thereon. Applicant submits, and the Examiner admits, that neither *Blanks*, *Andersen*, *Sauer* nor *Thurston*, taken alone or in combination, disclose a cable tie having a return loop connecting one end of a strap to

an integral hooked portion, with the return loop including at least one rib disposed thereon.

In the Office Action, the Examiner contends that *Andersen* discloses using a reinforcing rib (13) on a return loop (12', figure 1) to strengthen the hose clamp. Thus, the Examiner contends that it would have been obvious to one of ordinary skill in the art to add strengthening ribs to *Blanks'* metal tie band, to increase the strength of the tie band and to improve the reliability of the tie band. The Examiner further contends that the motivation arises from what the references would teach one of ordinary skill in the art.

In applying 35 U.S.C. §103(a), the Patent Office must: 1) consider the claimed invention as a whole; 2) consider the references as a whole when determining whether the references suggest the desirability of making a combination; 3) consider the references without the benefit of impermissible hindsight consideration of Applicants' disclosure; and 4) use a reasonable standard of success as the standard from which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, 229 USPQ 182, 187 (Fed. Cir. 1986).

In this case, it appears that the Examiner is not looking at the invention "as a whole", but instead is improperly focusing on the differences between the claims and the references (*i.e.*, providing stiffening ribs on the return loop of a cable tie). However, patent case law is clear that in considering the differences, the question is not whether the differences themselves would have been obvious, but rather whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713

F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Distilling an invention down to the gist of the invention disregards the requirement of analyzing the subject matter “as a whole.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983, *cert. denied*, 469 U.S. 851 (1984)). In addition, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97, 99-100 (Fed. Cir. 1983). The invention must be considered “as a whole.”

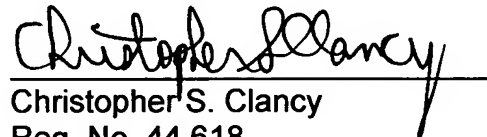
In order to consider the invention “as a whole”, however, the Examiner must view the context in which the invention was made, problems solved by the invention and the like. See *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) where it was held that in delineating the invention as a whole, one looks “not only to the subject matter literally recited in the claims . . . but also to the properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.” Also see *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) where it was found that the discovery of the source of a problem is also part of the “subject matter as a whole” inquiry. The Examiner has not made this inquiry.

In this regard, the claimed invention is directed to a stainless steel ball lock cable tie. As discussed in [0003] of the Background of the Invention, metallic bundling devices incorporating locking balls and roller pins have been used for bundling bales of cotton or the like since the Nineteenth Century. Such metal cable ties are known to one of ordinary skill in this art (*i.e.*, the field of cable ties), in addition to plastic cable ties. It is also well known to one skilled in this art that it would be desirable to increase the tensile strength and, thus, increase overall performance of a cable tie. However,

Applicant submits that *Andersen* would teach nothing to one of ordinary skill in the cable tie art because one of ordinary skill in the cable tie art would not be motivated by any teachings of a one-piece, circular hose clamp, when determining how to improve cable tie performance. Thus, it would not have been obvious to add reinforcing ribs to the metal tie band of *Blanks*. Accordingly, Applicant submits that claim 7 is patentable over the cited prior art. Claims 8-12 and 20-24 are asserted to be allowable based on their dependency from allowable claim 7.

In view of the above, Applicant submits that claims 7-12 and 20-24 are allowable and favorable reconsideration is respectfully requested.

Respectfully submitted,



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